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OFFICE OF PETITIONS

In re Application of :
GALLO et al. :
Application No. 09/375,924 : **DECISION ON PETITION**
Filed: 08/17/1999 :
Attorney Docket No. ABGX-2-CIP :

This is a decision on the petition under 37 CFR 1.181 (no fee), filed June 28, 2005, requesting withdrawal of the holding of abandonment in the above-identified application.

The petition is **GRANTED**.

This application was held abandoned for failure to reply to the final Office action mailed October 18, 2004, which set a three-month shortened statutory period for reply. In the absence of a timely filed reply, the application was held abandoned and a Notice of Abandonment was mailed on June 29, 2005.

Petitioner asserts that final Office action dated October 18, 2004, was not received.

A review of the written record indicates no irregularity in the mailing of the final Office action and in the absence of any irregularity, there is a strong presumption that the Office action was properly mailed to the practitioner at the address of record. This presumption may be overcome by a showing that the final Office action was not in fact received.

As stated in Section 711.03(c)(I)(A) of the Manual for Patent Examining Procedure:

In Delgar v. Schulyer, 172 USPQ 513 (D.D.C. 1971), the court decided that the Office should mail a new Notice of Allowance in view of the evidence presented in support of the contention that the applicant's representative did not receive the original Notice of Allowance. Under the reasoning of Delgar, an allegation that an Office action was never received may be considered in a petition to withdraw the holding of

abandonment. If adequately supported, the Office may grant the petition to withdraw the holding of abandonment and remail the Office action. That is, the reasoning of Delgar is applicable regardless of whether an application is held abandoned for failure to timely pay the issue fee (35 U.S.C. 151) or for failure to prosecute (35 U.S.C. 133).

To minimize costs and burdens to practitioners and the Office, the Office has modified the showing required to establish nonreceipt of an Office action. The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner describing the system used for recording an Office action received at the correspondence address of record with the USPTO. The statement should establish that the docketing system is sufficiently reliable. It is expected that the record would include, but not be limited to, the application number, attorney docket number, the mail date of the Office action and the due date for the response.

Practitioner must state that the Office action was not received at the correspondence address of record, and that a search of the practitioner's record(s), including any file jacket or the equivalent, and the application contents, indicates that the Office action was not received. A copy of the record(s) used by the practitioner where the non-received Office action would have been entered had it been received is required.

A copy of the practitioner's record(s) required to show non-receipt of the Office action should include the master docket for the firm. That is, if a three month period for reply was set in the nonreceived Office action, a copy of the master docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action. If no such master docket exists, the practitioner should so state and provide other evidence such as, but not limited to, the following: the application file jacket; incoming mail log; calendar; reminder system; or the individual docket record for the application in question.

The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Office action may have been lost after receipt rather than a conclusion that the Office action was lost in the mail (e.g., if the practitioner has a history of not receiving Office actions).

After reviewing the documents submitted on petition, the Office concludes that the showing of record is sufficient to warrant withdrawal of the holding of abandonment. The practitioner described the docketing system and the procedures for docketing due dates. The practitioner submitted a copy of a master docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action. Furthermore, the practitioner attested to the fact that a search of these records indicated that the final Office action was not received at the

correspondence address of record. Accordingly, petitioner presented the required showing under 37 CFR 1.181.

The petition under 37 CFR 1.181 is **GRANTED**. The holding of abandonment is hereby withdrawn. The \$130.00 fee submitted with the present petition will be refunded.

Technology Center Art Unit 1644 has been advised of this decision. The matter is being referred to the Technology Center's technical support staff for re-mailing of the final Office action of October 18, 2004. The three-month shortened statutory period to reply to the final Office action will be set to run from the re-mailing date of the Office action.

Telephone inquiries related to this decision may be directed to the undersigned at (571) 272-3211.

A handwritten signature in black ink, reading "C. T. Donnell". The signature is written in a cursive, flowing style.

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions